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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,056	11/29/2001	Shinji Aoyama	34169	7990

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EXAMINER

PEACHES, RANDY

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,056

Applicant(s)

AOYAMA, SHINJI

Examiner

Randy Peaches

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/7/02
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.

Claim Rejections - 35 USC § 112

Claims 1, 3, 6-7, 10-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, ***claims 1, 3, 6-7, 10-12*** recites the

broad recitation "***such as***", and the claim also recites "***control information***" which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. ***Claims 1-19*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Metso et al (U.S. Patent Number 5,920,826) in view of Buhrmann et al. (U.S. Patent Number 5,903,845).

Regarding ***claims 1, 6 and 11***, Metso et al discloses a mobile terminal (402), which reads on claimed "portable telephone", and a method of copying information, which reads on claimed "backing up data" and a portable computer (400), which reads on claimed "data backup equipment", where information stored in a said mobile terminal (402), such as a cellular phone, a personal handy phone, a car telephone, a maritime mobile radiotelephone, a satellite cellular phone machine or the like, said method comprising the steps of, as disclosed in column 7 lines 25-62, automatically transmitting, information (data), which reads on claimed "data such as at least control information or setup function information required for operating", said portable

telephone, telephone call information of telephone numbers, arrival telephone numbers, dispatch telephone numbers, call time and so on set and stored in said portable telephone (see column 7 lines 24-31) in association with a telephone call operation when a voice signal begins to be delivered and received for the telephone call between said portable telephone and personal computer (400), which reads on claimed "host office", see column 8 lines 21-30, via an interface cable and storing said data transmitted from said portable telephone in a said portable computer's (400) memory, which reads on claimed "data backup equipment", provided in or connected to said portable computer (400), whereby said data stored in said mobile terminal (402) are said copied.

However, Metso et al. does not disclosed where the transmitting means for the transfer of information from the said mobile terminal to the said portable computer is via a radio signal.

Buhrmann et al. teaches in column 3 lines 55-62, where the communication link used to transfer profile information may be via a wireless communication link, which reads on claimed "radio signal".

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify Metso et al (U.S. Patent Number 5,920,826) to include Buhrmann et al. (U.S. Patent Number 5,903,845) in order to provide a method of copying information from a said mobile terminal to a said portable computer via a wireless communication link, for purposes of backing up the said information contained in the said mobile terminal.

Regarding **claim 2**, as the combination of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) are made, the combination according to **claim 1**, wherein Metso et al further teaches in column 7 lines 24-62, where the method of copying information is characterized by automatically transmitting to said portable computer (400) the said data such as control information or setup function information required for operating said portable telephone, a telephone call information of telephone numbers, arrival telephone numbers, dispatch telephone numbers, call time and so on or other arbitrary data set and stored in said portable telephone. Buhrmann et al. further teaches in columns 3 and 8 lines 49-57 lines 59-67, respectively, of automatically transmitting said data, which reads on claimed "at an arbitrary time set by a timer".

Regarding **claims 3, 8 and 13**, as the combination of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) are made, the combination according to **claims (1 or 2), claim (6 or 7) and claims (10 through 12), respectively**, Metso et al further teaches where the said mobile terminal and method of copying information is characterized by further comprising the step of feeding back to said portable telephone said data stored in said data backup equipment provided in or connected to said host office whereby said data is re-memorized in said portable telephone. See Metso et al, column 7 lines 29-30.

Regarding **claims 4, 9 and 14**, as the combination of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) are made, the combination according to **claim 3, claims (6 or 7), and claim 14, respectively**, Metso et al further teaches where the said mobile terminal method and said of copying information is characterized by further comprising the step of arbitrarily selecting and setting said data to be transmitted to said host office or said data to be fed back to said portable telephone from said data backup equipment provided in or connected to said host office. See column 9 lines 9-17 lines 28-35, respectfully.

Regarding **claims 5, 15, and 16-19** as the combination of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) are made, the combination according to **claim 3, claims (11 or 12), claims (1 or 2), claim 4, claim 13 and claim 14, respectively**, Buhrmann et al. further teaches in columns 3 and 8 lines 49-57 lines 59-67, respectively of a data backup method for a said mobile terminal (402) comprising the step of automatically processing or converting into other information said data transmitted from mobile terminal (402) to said data backup equipment provided in or connected to Personal Information Manager (PIM) or portable computer, which reads on claimed "said host office", in case that said data have such predetermined conditions as said data are required to be processed whereby said processed or converted data are fed back.

Regarding **claim 6**, as the combination of Metso et al (U.S. Patent Number 5,920,826)

and Buhrmann et al. (U.S. Patent Number 5,903,845) are made, Buhrmann et al. further teaches in columns 3 and 8 lines 49-57 lines 59-67, respectively of a mobile terminal, wherein said data transmitter (see FIGURE 1) section characterized by automatically transmitting to a said Personal Information Manager (PIM) or portable computer, which reads on claimed "said host office", said data or other arbitrary data set and stored in said portable telephone at an arbitrary time set by a timer.

Regarding **claim 10**, as the combination of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) are made, Metso et al discloses a portable computer (400), which reads on claimed "data backup equipment" for backing up data stored in a mobile terminal (402), which reads on claimed "portable telephone", such as a cellular phone, a personal handy phone, a car telephone, a maritime mobile radiotelephone, a satellite cellular phone machine or the like. Buhrmann et al. further teaches in columns 3 and 8 lines 49-57 lines 59-67, respectively, by automatically notifying said mobile terminal (402) at an arbitrary time set by a timer that data such as control information or setup function information required for operating said portable telephone, a telephone call information of telephone numbers, arrival telephone numbers, dispatch telephone numbers, call time and so on set and stored in said mobile terminal should be transmitted to a said portable computer or PIM.

Regarding **claim 12**, as the combination of Metso et al (U.S. Patent Number 5,920,826) and Buhrmann et al. (U.S. Patent Number 5,903,845) are made, the combination

according to **claim 11**, Buhrmann et al. teaches of a Personal Information Manager (PIM) wherein, as taught in columns 3 and 8 lines 49-57 lines 59-67, respectively, automatically reads said data such as control information or setup function information required for operating said portable telephone, a telephone call information of telephone numbers, arrival telephone numbers, dispatch telephone numbers, call time and so on or other arbitrary data set and stored in said portable telephone at an arbitrary time set by a timer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (703) 305-8993. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Randy Peaches
June 13, 2004

Nguyen V.B.
6-14-04

NGUYEN T. VO
PRIMARY EXAMINER